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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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23409	7590	02/12/2007	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP			BATTULA, PRADEEP CHOURDARY	
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/607,233	BLOHM ET AL.
	Examiner	Art Unit
	Pradeep C. Battula	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 November 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-26 and 28-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This action is in response to the amendment filed on November 20, 2006

Response to Arguments

In response to the 35 U.S.C. 112, first paragraph rejections, Examiner withdraws the rejection.

In response to the 35 U.S.C. 112, second paragraph rejection, Examiner withdraws the rejection.

In regards to the generic book of Graushar not being an alternate piece and being of a different format. There is no indication that the generic book includes the associated signatures of 12, hence the reason it is a generic book. Therefore, if the associated signatures of 12 then it is not the same as contained within the rejected book and therefore is of alternate format and a generic book (Column 2, Lines 50 – 67; Column 3, Lines 1 – 4). The argument that the generic book is not an alternate piece and includes the same material is moot for the above reason and was also not previously claimed.

In regards to Anderson not disclosing an alternate piece having a different format, such was not claimed in the previous application. Only an alternate piece is claimed and a replica is not an original and therefore an alternate. In regards to the amendment, Graushar discloses this alternate piece with an alternate format and therefore meets the requirements of the amended claim.

In response to Claim 24, Applicant argues that Anderson fails to teach or suggest a binding method in which a pre-personalized signature is reprinted for a specific

individual's magazine after the original magazine with the specific individual's original pre-personalized signature is rejected. In Claim 1 Applicant states that Anderson discloses a method for producing magazines where when rejected an identical magazine is produced along with an identical pre-personalized signature. The argument for Claim 24 is moot.

In response to Claim 28, Anderson only says that if the magazine cannot be reordered before the end of the run then the manual intervention is needed. Anderson does not say the magazine cannot be ordered. Considering that the possible problem only occurs at the end of the zip code then it is inherent that the magazines keep order. Furthermore, with respect to replacing the space of the rejected book, Applicant did not claim that previously so the argument is irrelevant.

In response to Claim 31, please review the above statements. Furthermore, Applicant never claimed three separate replacement variations but only claimed three possibilities for a replacement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 15 – 17, 19, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al. (Anderson; U.S. 3,819,173).

In regards to Claim 15, Anderson discloses that it is known to have a method of replacing a rejected book on a binding line, the method comprising: generating a mailing list of recipients having a mailing order; assembling a pre-personalized book on the binding line for each recipient according to the mailing list; rejecting selective pre-personalized books; and generating an alternate piece on the binding line replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order (Column 1, Lines 37-65).

In regards to Claim 16, as applied to Claim 15, Anderson further discloses an alternate piece that is a postcard (Column 1, Lines 58-63).

In regards to Claim 17, as applied to Claim 15, Anderson further discloses the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information of the pre-personalized book (Column 1, Lines 58-63).

In regards to Claim 19, as applied to Claim 15, Anderson further discloses the alternate piece is a printed product (Column 1, Lines 58-63).

In regards to Claim 24, Anderson discloses that it is known in the art to have a binding method comprising: generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature; rejecting selective pre-personalized books; reprinting the pre-personalized signature of one of the rejected book pre-personalized books and; then regenerating the rejected pre-personalized book on the binding line for the specific

individual to include the reprinted pre-personalized signature (Column 1, Lines 37-65; Argument to Claim 1).

In regards to Claim 25, as applied to Claim 24, Anderson further discloses the step of reprinting the portion is done on the binding line (Column 1, Lines 58-63).
2. Claims 21 and 23 rejected under 35 U.S.C. 102(b) as being anticipated by Graushar et al. (Graushar; U.S. 6,347,260 B1).

In regards Claim 21, Graushar discloses a binding method comprising: generating a mailing list of recipients; generating a pre-personalized printed product off-line for selected recipients on the mailing list; the ability to load the pre-personalized printed products adjacent the binding line (Figure 1, Item 14); assembling a book for each recipient including a respective pre-personalized printed product; rejecting selective recipients' books; and generating an alternate piece in place of each rejected book the alternate piece being of a different format than the pre-personalized printed product (Column 2, Lines 1-15 and Column 3, Lines 1-3).

In regards to Claim 23, as applied to Claim 21, Graushar further discloses the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected (Column 3, Lines 1-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 –3, 5 –7, 28, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (Anderson; U.S. 3,819,173) in view of Graushar et al. (Graushar; U.S. 6,347,260 B1).

In regards to Claim 1, Anderson discloses that it is well known to generate a pre-personalized book on a binding line for a specific individual; rejecting selective pre-personalized books; and generating an alternate piece in place of each rejected pre-personalized book to be delivered to the specific individual (Column 1, Lines 37-65).

Anderson does not disclose generating an alternate piece having an alternate format from the pre-personalized book.

Graushar discloses generating an alternate piece having an alternate format from a pre-personalized book (Column 2, Lines 50 – 67; Column 3, Lines 1 – 4). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teaching of Graushar to produce an alternate piece with an alternate format in order to prevent extended holds on a production line for an identical piece.

In regards to Claim 2, as applied to Claim 1, Anderson modified by Grausher further discloses that the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information (Column 1, Lines 58-63; Anderson).

In regards to Claim 3, as applied to Claim 1, Anderson further that the pre-personalized book includes a pre-personalized signature (Column 1, Lines 8-10; Anderson).

In regards to Claim 5, as applied to Claim 1, Anderson modified by Graushar further the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 1, Lines 58-63; Anderson).

In regards to Claim 6, as applied to Claim 1, Anderson modified by Graushar further the alternate piece is a printed product (Column 1, Lines 58-63; Anderson).

In regards to Claim 7, as applied to Claim 6, Anderson modified by Graushar further an alternate piece that is a postcard (Column 1, Lines 58-63; Anderson).

In regards to Claim 28, Anderson discloses that it is known in the art to have a binding method comprising: generating a mailing list of recipients; generating a pre-personalized printed product for each recipient; assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece; rejecting selective books; and removing the rejected books from respective spaces along the binding line and generating an alternate pre-personalized piece for each recipient whose book was rejected (Column 1, Lines 37-65).

Anderson does not disclose inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Graushar discloses inserting an alternate piece into a space previously occupied by a rejected book (Column 3, Lines 1 – 4). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the

teaching of maintaining order of Graushar and apply it to Anderson in order to maintain order of personalized materials.

In regards to Claim 29, as applied to Claim 28, Anderson modified by Graushar further discloses wherein generating the alternate pre-personalized piece is done on the binding line (Column 1, Lines 58 – 65; Anderson).

In regards to Claim 31, Anderson modified by Graushar discloses generation of a mailing list of recipients, on line assembly of pre-personalized books for each recipient, rejecting selected books and then replacing them (Column 1, Lines 48-65; Anderson) and a replacement that is either a regenerated book identical to what the rejected book should have been or, the generation of an alternate piece (Column 1, Lines 58 – 64; Anderson).

Anderson does not disclose the ability to do several different replacements or the replacement with a generic book or alternate format piece.

Graushar discloses the replacement of a rejected book with a generic book which also acts as an alternate format piece (Column 2, Lines 50 – 67; Column 3, Lines 1 – 4). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to enable Anderson to allow for the feeding of a generic and alternate piece in addition to an identical replacement for different book rejections in order to allow for a backup rejection piece in case another fails or becomes unavailable.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable in further view of Pace et al (Pace; U.S. 5,713,605).

In regards to Claim 8, as applied to Claim 1, Anderson modified by Grausher does not disclose the alternate piece is in electronic format.

Pace discloses a compact disk insert 50 containing a disk for binding compact disks into a bound publication without the need for specialized insert and binding machinery (Column 1, Lines 47 – 65; Figure 1, Item 50). Pace further discloses it is well known to have various forms of information on the compact disks (Column 1, Lines 9 – 17). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Pace's insert in Grausher's generic book in order to make the generic book more appealing to the customer.

3. Claims 9 – 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of and Pace.

In regards to Claim 9, Anderson discloses that it is known in the art to generate a mailing list of recipients; generate a pre-personalized book for each recipient on a binding line; rejecting one of the pre-personalized books; identifying the recipient of the [each] rejected pre-personalized book; and generating an alternate piece for each rejected pre-personalized book (Column 1, Lines 37-65).

Anderson does not disclose that the alternate piece includes a notification to the recipient regarding their pre-personalized book.

Pace discloses Pace discloses a compact disk insert 50 containing a disk for binding compact disks into a bound publication without the need for specialized insert and binding machinery (Column 1, Lines 47 – 65; Figure 1, Item 50). Pace further discloses that it is known in the art to have various kinds of information on a disk to be

sent to an individual (Column 1, Lines 9 – 17). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to bind Pace's invention into Anderson's alternate piece in order to have the compact disk explain any deficiencies that may have occurred with the replacement piece.

In regards to Claim 10, as applied to Claim 9, Anderson modified by Pace further discloses Anderson discloses the alternate piece is a printed product (Column 1, Lines 58-63; Anderson).

In regards to Claim 11, as applied to Claim 9, Anderson modified by Pace further discloses Anderson discloses the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information (Column 1, Lines 58-63; Anderson).

In regards to Claim 12, as applied to Claim 9, Anderson modified by Pace further discloses Anderson discloses the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 1, Lines 58-63; Anderson).

In regards to Claim 14, as applied to Claim 9, Anderson modified by Pace further discloses that the alternate piece is in electronic format (Column 1, Lines 47 – 65; Pace).

4. Claim 4 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Graushar and Clark (U.S. 5,428,423).

In regards to Claim 4, as applied to Claim 1, Anderson modified by Graushar does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

In regards to Claim 30, as applied to Claim 28, Anderson modified by Graushar does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Pace and Clark.

In regards to Claim 13, as applied to Claim 9, Anderson modified by Pace does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

6. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Clark (U.S. 5,428,423).

In regards to Claim 18, as applied to Claim 15, Anderson does not disclose how to make the alternate piece's information different from the books pre-personalized information.

Clark discloses a printer which takes input information and will print the same information onto an alternate piece. The information can be customized so, it be the same or different from the pre-personalized information of the book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's printing method to provide the ability to alter the pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

In regards to Claim 26, as applied to Claim 24, Anderson does not disclose how to make the alternate piece's information different from the books pre-personalized information.

Clark discloses a printer which takes input information and will print the same information onto an alternate piece. The information can be customized so, it be the same or different from the pre-personalized information of the book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's printing method to provide the ability to alter the pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar in view of Clark.

In regards to Claim 22, as applied to Claim 21, Grausher does not disclose that the alternate piece produced has at least a portion of the pre-personalized information the pre-personalized book contains.

Clark discloses a method of printing that produces a pre-personalized printed product that can be produced offline as an alternate piece and customized to include a portion of the pre-personalized information of the book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Graushar's method to include the use of Clark's off-line printing to provide the ability to use some of pre-personalized information in

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order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

Conclusion

Applicant's arguments with respect to claims 1 – 26 and 28 – 31 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
January 29, 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER